APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,988	02/12/2002	Chris E. Rowen	OTG0002-US	3521

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EXAMINER
LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/072,988	ROWEN, CHRIS E.
	Examiner	**Art Unit**	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>05 May 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-44* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-44* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   The amendment filed 5/5/2005 has been placed of record in the file.

2.   Claims 1, 8, 15, 21, 30, and 37 have been amended.

3.   Claims 1-44 are now pending.

4.   The applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the following new grounds of rejection.

Response to Amendment

5.   Claims have been amended to show storage in a single shared index file. The amendment proves a change in scope to the independent claims as the independent claims now explicitly state the use of a single shared index file. However, none of the amended claims show a patentable distinction over the prior art as evidenced by the following new grounds of rejection.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-3, 5-10, 12-18, 20-23, 25-32, 34-39, and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (U.S. Patent Number 5,999,932) in view of Cloutier et al. (U.S. Patent Number 6,535,586), hereinafter referred to as Cloutier.

8.   Paul disclosed a system that uses data matching for identifying emails desired by a user. In an analogous art, Cloutier disclosed a method for generating a unique code for email messages in a system for the notification and retrieval of stored email.

9.   Concerning claim 1, and like claims, Paul did not explicitly state computing a message tag from at least a portion of the plurality of message properties or using a single shared index file. However, Cloutier's system is focused on the generation of unique codes or tags for email messages. Although Paul utilizes singular inclusion lists or index files for each user, it would be a clear extension of his system to move this functionality to a server or like device that would maintain an index file for the whole system. This is also evidenced by Cloutier who utilizes a messaging system server for completing the email processing for all the users in the system. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Paul by adding the ability to compute a message tag from at least a portion of the plurality of message properties and use a single shared index file as provided by Cloutier. Here, the combination satisfies the need for a system to more efficiently sort email messages. See Paul, column 1, lines 9-13. This rationale also applies to those dependent claims utilizing the same combination.

10.   Concerning claims 5 and 6, and like claims, the combination of Paul and Cloutier did not explicitly state computing the message tag by concatenating the sender's name, the sender's submission time, and the subject. However, the combination does state computing tags by concatenating data from an email header, especially noting the use of the "Date" and "From" fields. Although the sender's name is not explicit, this would be a clear extension of data in a "From" field of an email header. Although the sender's submission time is not explicit, this

would be a clear extension of data in a "Date" field of an email header as various dates and times

are often used in email headers. Although the subject is not explicit, this would be a clear

extension of the system since the system utilizes data from the email header and an email subject

line is exemplary of such data. Thus it would have been obvious to one of ordinary skill in the

art at the time of the applicant's invention to modify the combination of Paul and Cloutier by

adding the ability to compute the message tag by concatenating the sender's name, the sender's

submission time, and the subject.

11.   Some claims will be discussed together. Those claims which are essentially the same

except that they set forth the claimed invention as an alternative method or a system are rejected

under the same rationale applied to the described claim.

12.   Thereby, the combination of Paul and Cloutier discloses:

- <Claims 1, 8, 15, 21, 30, and 37>

   A method for identifying a unique electronic mail message in a plurality of electronic

   email messages extracted from an electronic mail messaging system, the method

   comprising: retrieving a message from a mailbox on the electronic mail messaging

   system, the message including a plurality of message properties (Paul, column 8, lines

   22-24); computing a message tag from at least a portion of the plurality of message

   properties (Cloutier, column 6, lines 7-13); reviewing a list of message tags (Paul,

   column 8, lines 24-27) stored in a single shared index file (Cloutier, column 3, lines 43-

   61); determining whether the message is unique based upon whether the message tag is

   found in the single shared index file (Paul, column 8, lines 24-31); and storing the

message tag in the single shared index file if the message is unique (Paul, column 8, lines 31-34).

Claims 8 and 30 also contain limitations similar to Claim 5 discussed below.

- <Claims 2, 17, 22, and 38>

The method of claim 1, wherein the message tag is computed by concatenating at least two properties selected from the plurality of message properties (Cloutier, column 6, lines 7-13).

- <Claims 3, 10, 18, 23, 28, 32, 39, and 44>

The method of claim 2, wherein the message tag is further computed by applying a hash algorithm to the message tag to form a uniform string, wherein the uniform string has a predetermined length (Cloutier, column 6, lines 7-13).

- <Claims 5, 9, 16, 26, 31, and 42>

The method of claim 1, wherein the plurality of message properties includes a sender's name and a sender's submission time, and wherein the message tag is computed by concatenating the sender's name to the sender's submission time (Cloutier, column 6, lines 7-13 and obviousness).

- <Claims 6, 27, 34, and 43>

The method of claim 1, wherein the plurality of message properties includes a sender's name, a sender's submission time and a subject, and wherein the message tag is computed by concatenating the sender's name and the subject to the sender's submission time (Cloutier, column 6, lines 7-13 and obviousness).

- <Claims 7, 13, 20, 29, and 35>

  The method of claim 1, wherein the index file is stored in a relational database system (Cloutier, figure 1, item 120).

- <Claims 12, 25, and 41>

  The method of claim 8, wherein the first mailbox and the second mailbox are different mailboxes on the electronic mail messaging system (Paul, column 7, lines 42-45).

- <Claims 14 and 36>

  The method of claim 8, wherein the message archive is a relational database system (Paul, column 7, lines 45-51).

Since the combination of Paul and Cloutier discloses all of the above limitations, claims 1-3, 5-10, 12-18, 20-23, 25-32, 34-39, and 41-44 are rejected.

13.   Claims 4, 11, 19, 24, 33, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Cloutier, as applied above, further in view of Sundsted (U.S. Patent Number 5,999,967).

14.   The combination of Paul and Cloutier disclosed a system that uses data matching for identifying emails desired by a user and can generate a unique code for emails. In an analogous art, Sundsted disclosed a method for sorting email that uses electronic stamps which contain a hash field.

15.   Concerning claim 4, and like claims, the combination of Paul and Cloutier did not explicitly state the use of an MD5 hash algorithm. However, the combination does use a hash algorithm and MD5 was well known in the art as evidenced by Sundsted whose email sorting

system utilizes MD5. It would have been obvious to one of ordinary skill in the art at the time of

the applicant's invention to modify the combination of Paul and Cloutier by adding the ability to

use an MD5 hash algorithm as provided by Sundsted. Here, the combination satisfies the need

for a system to more efficiently sort email messages. See Paul, column 1, lines 9-13.

16.   Thereby, the combination of Paul, Cloutier, and Sundsted discloses:

- <Claims 4, 11, 19, 24, 33, and 40>

  The method of claim 3, wherein the hash algorithm is an MD5 hash algorithm (Sundsted,

  column 7, lines 12-15).

Since the combination of Paul, Cloutier, and Sundsted discloses all of the above limitations,

claims 4, 11, 19, 24, 33, and 40 are rejected.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to the applicant's

disclosure.

- Nielsen (U.S. Patent Number 6,108,688) disclosed an email sender's system that

  maintains a database and automatically monitors incoming messages in order to update

  the database as responses are received.

- Mertama et al. (U.S. Patent Number 6,629,130) disclosed a method for creating services

  in order to process the content of new email messages.

- Townshend (U.S. Patent Number 6,829,635) disclosed a system that tracks the contents

  of a plurality of email messages.

18.   The applicant's amendment necessitated the new grounds of rejection presented in this

office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The

applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

19.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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